

Remarks/Arguments

Reconsideration of this application is requested.

Claims 1, 4 and 17 have been objected to by the Examiner. Claims 1, 4 and 17 have been amended to overcome the Examiner's objections.

Claims 9 and 11-16 have been rejected by the Examiner under 35 U.S.C § 112 for being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 11-16 have been amended to overcome the Examiner's rejection.

Claims 1-2, 4, 7-11, and 18-19 have been rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Publication No. 2004/0064422 in view of Schwartz et al., U.S. Publication No. 2002/0073040.

Leon discloses the following in paragraph 0031.

"[0031] One aspect of the invention provides a method of tracking and accounting for reply mailpieces that are sent in response to receiving outgoing mailpieces, such as payments sent in response to bills received. A related aspect includes a mailpiece supporting this method. The method according to this aspect of the invention is participated in by a mailer, a recipient, a postage vendor (PV), and a postal service. In this method, the mailer sends an outgoing mailpiece to the recipient, who in turn assembles and mails a reply mailpiece (possibly, but not necessarily to the mailer). The reply mailpiece includes one or more components (reply component(s)) from the outgoing mailpiece, and may further include components provided by the recipient, for example a check. In some embodiments, the outgoing mailpiece includes an outgoing envelope, in which are located a reply envelope and other inserted materials. The reply components thus include the reply envelope, and typically at least a portion of the inserted materials."

Leon discloses the following in paragraph 101.

"[0101] Recipient and reply segments are in most material respects like mailpiece 45, with the following exceptions. First, MI code 60 (reply) is generated by or for the mailer, is associated with an account of the mailer, and therefore results in the postage for the reply mailpiece to be charged to the mailer. In current practice,

mailers such as utility companies and phone companies do not provide postage prepaid envelopes. This can lead to many bill payments being delayed or lost due to a lack of sufficient postage."

Leon discloses the following in paragraph 108.

"[0108] Reply segment 75 and additional component 125 (if any) are inserted into reply envelope 105 with the information in area 82 (recipient) and 85 (recipient) showing through openings 107 and 10S in reply envelope 10S. The recipient mails the reply mailpiece, which then enters the mail stream (step 130). Since the reply mailpiece bears reply MI code 60 (reply), the reply mailpiece is tracked and the mailer is charged for the postage (step 135). The reply mailpiece then reaches the mailer (step 140)."

Leon discloses a method for tracking and accounting for reply mailpieces.

Leon does not disclose a method for paying for international business reply mail.

The Examiner stated the following on page 4 of the Patent Office Action.

"Leon does not teach a second carrier, a second country, and paying the second carrier the amount charged to the sender's meter for the second carrier postage. Schwartz teaches FedEx is a second carrier that may be used in the mailing system and method (Schwartz: Figure 7, paragraphs 0010-0011, "FedEx" is a second courier different from the postal authority.). Schwartz further teaches paying the second carrier the amount charged to the sender's meter for the second carrier postage (Schwartz: paragraphs 0010 and 0059). Schwartz does not teach sending mail between two countries (a second country). However, Official Notice is taken that it was old and well known in the art of the shipping industry that FedEx is an international shipping carrier that regularly ships between different countries. It would have been obvious to have modified Schwartz to include the teachings of Official Notice because shipping to multiple countries allows businesses to interact globally, that is, on a much larger scale than domestically."

Schwartz discloses the following in paragraphs 0010-0011.

"[0010] Still further, we have revolutionized the concept of a postage indicium which is traditionally used as a proof of postage for mailing services rendered by a postal authority, such as the United States Postal Service (USPS). We have recognized that a postage indicium is documentation of a transaction by the originator of the indicium. Thus, in accordance with another aspect of the invention, by incorporating, in addition to the traditional postal data, transactional data including a transaction amount and payment instructions in a postage indicium, the indicium becomes a money order payable to a specified payee. In that instance, when the

postal authority inspects the indicium, recognizing that at least part of the indicium represent, a money order, the postal authority acts as a payer bank and pays the transaction amount to the specified payee according to the payment instructions. As such, the postage indicium can be used not only as a proof of postage for the mail piece being delivered by the postal authority, but also as a money order to pay bills or repay debts to any party which mayor may not be the recipient of the mail piece.

[0011] In particular, by specifying the payee of the money order represented by the indicium to be a courier (e.g., FedEx) different from the postal authority, and the transaction amount to be the cost of the courier service, we have invented a universal postage indicium for paying any courier service."

Schwartz indicium 700 includes a human readable portion 705 and bar code portion 710. Human readable portion 705 includes a postage payment of \$0.32 represented by character 709 and a payment of \$10.00 to XYZ Co. represented by character 708. The data in portion 710 includes transactional data that is readable by the postal authority.

When the postal authority reads the data in portion 710 it recognizes that at least a part of portion 710 represents money that is due XYZ Co.

Leon and/or Schwartz taken separately or together do not disclose or anticipate the step of charging a sender's meter located in the first country for postage for an authorized maximum number of business reply mail that is due to the second carrier for processing the business reply mail that is deposited by a recipient with the second carrier; as claimed in claim 1 as amended.

Claims 15-16 have been rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Publication No. 2004/0064422 in view of Schwartz et al., U.S. Publication No. 2002/0073040 and in view of Walker et al., U.S. Patent No. 6,978,248 and further in view of Baer et al., U.S. Patent No. 4,999,481.

Baer discloses the following in col.5, lines 42-50.

"The batch number is one assigned by the user through the input/processor 38 whereby a given batch of mail. i.e., mail of a particular type or character, will be identified by a number assigned by the user. In addition, a run number, which is a subset of the batch, may be given to identified particular segments of the batch.

Also, each mail piece may be numbered sequentially during each batch of mail processing."

Baer discloses the following in col. 2, lines 6-28.

"A system has been conceived whereby a mailer is able to send large quantities or batches of mail without the need of on-site inspections. This is accomplished by the mailer having a secure accounting unit similar to a postage meter in which postage value is received from a dispensing or central station by charging a descending register in the accounting unit. A statement accompanies each batch of mail which statement contains information relative to the mail and the amount of postage required. Communication between the central station and the mail sender allows postage value to be transferred to the user by the central station and mailing and verification data to be sent to the central station from the mailer. The mailing and verification data will be the same as that contained on the mailing statements that accompany the batches of mail. This system provides a central station for a large number of mail senders whereby the postal service is relieved of its obligation of having on-site inspections and the central station acts as a clearing house for the postal service through whom verification of postage can be conveniently and inexpensively achieved."

Baer counts the number of mail pieces that are sent in a batch so that the post will not have to inspect the mail piece to determine when the mailer delivers them to the post there will be correct number of pieces and the correct postage would have been paid. The post does the foregoing working sharing process to save money. This process is done for only large amounts of incoming (permit) mail not for counting the number of international business reply mail pieces that are processed by the first and second carrier. The second carrier will receive individual business reply mail pieces after a customer mails them.

Walker discloses the following in col. 11, lines 49-55.

"The total number of responses for each mailing list are stored at step 1004. At step 1005, the response rate of each mailing list is calculated corresponding to the test identifier based on the number of test e-mails sent and the number of responses received. The mailing list corresponding to the test identifier with the highest

response rate is then selected at step 1006. At step 1007, that mailing list is queued for the postal-mailing process."

Walker discloses the following in col.2, lines 35-45.

"In one embodiment of the present invention, a method for providing a mailing list test service is disclosed. This mailing list test service tests a plurality of mailing list, each mailing list including information about a plurality of list members. To perform the test, a computer-based message, such as an electronic mailing (e-mail), is sent to each of a subset of list members for each mailing list. At least one response from a list member is received, and based on the received responses, one of the mailing lists is selected for use in a postal mailing campaign."

Walker discloses a mailing list test service.

The art cited by the Examiner does not disclose or anticipate counting the number of business reply mail pieces processed by the first and second carriers.

Claim 17 is rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Leon in view of Schwartz and further in view of Fredman, U.S. Patent No. 6,526,393.

Fredman discloses the following in col. 2, lines 17-21.

"FIG. 1 shows a representation of a proposed "Urgent Reply Mail" envelope with a predetermined effective expiration date. "Urgent Reply Mail" is a term created for descriptive and clarification of this method. Said representation could also be used for a card as well. FIG. 2 shows a representation of a Stamp/postage with a predetermined effective expiration date. Said stamp could be affixed on an envelope, card, box, tube, pak, or other method of delivery."

Fredman discloses the following in his abstract.

"A method for generating, providing, and utilizing time controlled date sensitive pre-paid postage on an item to be delivered, including a desired delivery amount and personalized postage mark, with the intention of causing action prior to a chosen date. An Issuer would send prepaid postage to a Recipient with a chosen effective date and a chosen expiration date. Said effective date and expiration date would allow Issuer to encourage Recipients to initiate action within a predetermined time window. After effective expiration date, postage would expire requiring new

postage/delivery fees to be added to the item for it to be mailed/delivered."

Fredman discloses a method for pre-paying postage until a certain date that does not use a meter.

The art cited by the Examiner does not disclose or anticipate indicating on the international business reply mail an expiration date that the sender's meter will be charged for processing specific batches of international business reply mail.

The art cited by the Examiner also does not disclose or anticipate new claims 20 and 21.

Please charge any additional fees that may be required or credit any overpayment to Deposit Account Number 16-1885.

In view of the above claims 1-19 as amended and new claims 20 and 21 are patentable. If the Examiner has any questions would he please contact the undersigned at the telephone number noted below.

Respectfully submitted,

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